

REMARKS

Claims 46-71 are rejected under 35 U.S.C. §102(b) as being anticipated by Ito et al (U.S. Patent 5,881,032). Examiner's rejections are herein respectfully traversed.

REJECTIONS UNDER 35 U.S.C. §102(b):*EXPRESS ANTICIPATION*

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicant respectfully disagrees with Examiner's rejection of claims 46 through 71 based on Ito et al., which discloses a relationship between sector addresses and the inner and outer circumferences of an optical disc. Ito et al. discloses and teaches that the sector addresses of the information may be organized with respect to the inner and outer radii of the optical disc and on which layer the information is located. For example, "the addresses assigned to sectors at the same radial positions on even and odd-numbered layers are numbers in a complimentary relationship." Ito et al., Col. 4, Ln 44. Ito et al. does not disclose a similar relationship between sector addresses within the same recording layer. In contrast, Applicant's claims 46 through 71 recite two different addresses - recorded addresses and physical addresses, within a single recording layer. As such, Ito et al. does not expressly describe every element contained in claims 46 through 71, and claims 46 through 71 are therefore not anticipated.

INHERENT ANTICIPATION

The express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103. MPEP 2112. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). Inherency cannot be based on probabilities or possibilities. It is not sufficient to support inherency that a certain outcome may result from a given set of circumstances. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999).

The Examiner has not sufficiently demonstrated how Ito et al. inherently anticipates claims 46 through 71. The recorded addresses of claims 46 through 71 are recorded during recording on the optical disc. No such recorded address is suggested in Ito et al., which instead

discloses only sector addresses. Examiner agreed that such sector addresses are established during manufacture of the disc. Office Action, November 14, 2006, page 10. As such, the sector addresses as recorded by Ito et al. cannot be read as and are not the recorded addresses as recited in claims 46 through 71. As such, Ito et al. cannot inherently anticipate relationships between the recorded and physical addresses because no such relationships between addresses necessarily flow from Ito et al.'s disclosure of a single sector address.

Independent claims 46, 50, and 54

With regard to independent claims 46, 50, and 54, the Examiner states on pages 2 through 5 of the Office Action that the recorded addresses would inherently increase with the physical addresses in the direction of reproduction, given FIG. 1D; however, claim 54 specifically recites that "the recorded addresses and the physical addresses increase or decrease oppositely."

In FIG. 1D of Ito et al., the direction of reproduction progresses from the inner radius of the disc to the outer radius of the disc on the first recording layer and then from the outer radius to the inner radius on the second recording layer. Thus, the sector addresses increase oppositely in two different layers with regard to radial position on the disc. However, in claims 46, 50, 54, the recorded addresses increase in parallel or oppositely in the same direction in the same recording layer. One address increasing in different physical directions in different recording layers does not inherently anticipate two addresses – increasing in parallel or oppositely - in the same physical direction in the same recording layer.

The organization of the recorded addresses with respect to physical addresses as disclosed by Applicant and claimed in claims 46, 50, and 54 does not necessarily flow from the sector addresses increasing in the direction of reproduction as illustrated in FIG. 1D in Ito et al.

Independent claims 48, 61, and 65

With regard to independent claims 48, 61, and 65, Examiner asserts on pages 3, 7, and 8 of the Office action that column 5, lines 23 through 32, provides "for the recorded address – or sector address provided to the sector – of either layer to increase or decrease as the physical address – sector – increases." Given that Ito et al. only discloses relationships between sector addresses and the radius on an optical disc, Applicant respectfully submits that column 5, lines 23 through 32, do not anticipate claims 48, 61, and 65, expressly or inherently.

Column 5, lines 23 through 32, contain only descriptions and illustrations of the relationships of sector addresses to the inner and outer circumferences of an optical disc. Ito et al. does not describe a relationship between recorded addresses of smallest recording units and physical addresses. Thus, the Examiner's above statement incorrectly correlates Ito et al.'s

sector address with both a recorded and a physical address.

And, because of the above, the Examiner has not sufficiently indicated how these lines inherently anticipate claim 48, 61, and 65. The relationship of the sector addresses with the inner and outer circumferences of an optical disc in no way implies or inherently discloses a relationship between recorded addresses and physical addresses. "[T]he recorded addresses and the physical addresses increase or decrease oppositely" (claim 48 and 65) does not invariably flow from column 5, lines 23 through 32, as demonstrated by the language of claim 61 wherein the recorded and physical addresses increase or decrease in parallel. Therefore, column 5, lines 23 through 32, do not expressly or inherently anticipate claims 48, 61, and 65.

Column 5, lines 23 through 32, describe that the sector addresses increase on a first recording layer from one circumference side on the disc to another and increase on a second recording layer from the other circumference side to the one. So, the sector addresses increase in two physical directions in two different layers. Claims 48, 61, and 65 describe the recorded addresses increasing in parallel or oppositely in the same physical direction in one physical layer. As such, Ito et al. does not inherently anticipate claims 48, 61, and 65.

As dependent claims 47, 49, 51 through 53, 55 through 60, 62 through 64, and 66 through 71 all depend upon independent claims not anticipated by Ito et al. and incorporate all of the limitations therein, such dependent claims are also not anticipated by Ito et al. for similar reasons.

Ito et al. cannot expressly anticipate claims 46 through 71 of the current application as each and every element of the claims is not expressly contained in Ito et al. Ito et al. also cannot inherently anticipate claims 46 through 71 of the current application as the elements described and claimed therein do not necessarily or invariably flow from Ito et al.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

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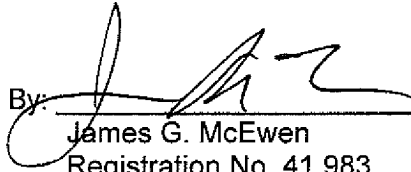
Docket No.: 1293.1320

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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